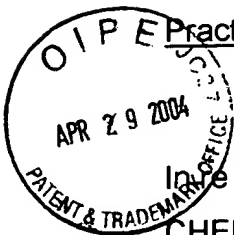


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Practitioner's Docket No. D-7102

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of

CHERYL B. LEBEAU, et al

Serial No: 09/303,632

Filed: May 3, 1999

For: DISPOSABLE PLASTIC KEYBOARD
COVER

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Group Art Unit 2854

Examiner: L.J. Evanisko

REVISED APPELLANT'S BRIEF (37 C.F.R. § 1.192)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This brief is in furtherance of the Notice of Appeal, filed in this case on 5/21/2002. A Notice of Appeal fee of \$160.00 was paid on 5/21/2002. The Appellant's Brief fee of \$160.00 was paid on 7/30/2002.

Accordingly, the fees required under § 1.17, and any required petition of extension of time for filing this brief and fees therefore, are dealt with in the accompanying one-month extension of time.

This revised brief is transmitted in triplicate. (37 C.F.R. § 1.192(a))

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Patents, Mail Stop Appeal Brief-Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date:

April 26, 2004

Arthur G. Yeager
Arthur G. Yeager, Reg. No. 19,892

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192 (c)):

- I. REAL PARTY INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF INVENTION
- VI. ISSUES
- VII. GROUPING OF CLAIMS
- VIII. ARGUMENTS
 - ARGUMENT: VIIIA REJECTIONS UNDER 35 U.S.C. 102(b)
 - ARGUMENT: VIIIB REJECTIONS UNDER 35 U.S.C. 103(a)
- IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
- IX. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE

The final page of this brief bears the practitioner's signature.

- I. REAL PARTY IN INTEREST (37 C.F.R. § 1.192 (c)(1))

The real party in interest in this appeal is:

the party named in the caption of this brief.

- II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

With respect to other appeal or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

there are no such appeals or interferences.

- III. STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

The status of the claims in this application is:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 21-38, 41 and 42 (Total Claims=20)

B. STATUS OF ALL OF THE CLAIMS

- 1. Claims cancelled: 1-20; 39-40
- 2. Claims withdrawn from consideration but not cancelled: None
- 3. Claims pending: 21-38; 41, 42

4. Claims allowed: None.
5. Claims rejected: 21-26, 28-30, 32-37, 41 and 42
6. Claims objected to: 27, 31 and 38.

C. CLAIMS ON APPEAL

The claims on appeal are 21-26, 28-30, 32-37, 41 and 42.

IV. STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

An amendment was filed on October 13, 2003 after an Office Action of April 2, 2003 and a Notice of Non-Compliant Amendment of September 16, 2003. The Examiner filed a Final Action dated January 6, 2004.

V. SUMMARY OF INVENTION (37 C.F.R. § 1.192(c)(5))

A. The present invention (FIGS. 3-5) is a package (33) of individual disposable transparent covers (23) having a predetermined size in length and width. Each cover (23) includes at least one flat and entirely transparent planar sheet of pliable plastic film having two strips of adhesive (24) on the cover (23) and positioned to contact a keyboard frame (32) without interfering with the operation of a keyboard (20) and the associated keys (21). The lateral edges of a cover (23) may extend beyond the lateral edges of the keyboard (20).

B. A second embodiment (FIGS. 6 and 7) of a cover 25 defines the at least one sheet to be an envelope having an open side (26) and three closed sides (31). The envelope may be formed by folding a single sheet of plastic film over itself and heat sealing the edges (31) or by heat sealing two superimposed sheets of plastic film along three side edges (31).

C. A third embodiment (FIGS. 8 and 9) of the cover (25) defines the at least one sheet to be an open-ended tubular sleeve preferably formed by folding a plastic film to form two layers (28) with at least one open end (29) and two elongate sides (30)(31). Sealed side (30) terminates generally medially at point (30A) to allow an opening (30B) to accommodate an electrical cord that connects the keyboard (20) to a computer (not shown). The sleeve can also be formed in a manner similar to sleeve (25) by using two single layers (28).

VI. ISSUES (37 C.F.R. § 1.192(c)(6))

The final rejection is grounded on 35 U.S.C. 102 and 103(a).

The issues on appeal are as follows:

- A. Whether Claims 32, 35-37, 41 and 42 are anticipated by Gaible et al?
- B. Whether Claims 32 and 35-37 are obvious over Yanagisawa in view of Adair?
- C. Whether Claim 33-34 are obvious over Yanagisawa in view of Adair as applied to Claims 32, 35-37 and further in view of either Okamura or Young?
- D. Whether Claims 21 and 24-26 are obvious over Yanagisawa in view of Adair and the IBM reference?
- E. Whether Claims 22-23 are obvious over Yanagisawa in view of Adair and the IBM reference?
- F. Whether Claims 21, 24-26, and 28-30 are obvious over Gaible et al in view of the IBM reference?

VII. GROUPING OF CLAIMS (37 C.F.R. § 1.192 (c)(7))

The Claims in the present application are grouped as follows:

- (a) Claims 21 and 24-26 are grouped together;
- (b) Claims 22-23 are grouped together;
- (c) Claims 28-30 are grouped together;
- (d) Claims 32, 35-37 are grouped together;
- (e) Claims 33-34 are grouped together; and
- (f) Claims 41 and 42 are grouped together.

VIII. ARGUMENTS-REJECTIONS UNDER 35 U.S.C § 102(b)

A. Claims 32, 35-37, and 41-42 are believed not to be anticipated by Gaible et al.

1. Gaible et al discloses a clear flexible bag (30) formed with a pair of plastic side walls (32a, 32b), which may be heat-sealed together along edges (33a, 33b) to define a container with an open end (36).

Contrary to the Examiner's assertion on page 3 of the Final Rejection (FR), penultimate sentence, Gaible et al does not disclose an "entirely transparent planar

sheet", nor a "pliable plastic film" nor that such film be of "uniform thickness throughout" as called for in claim 32, for example. Furthermore, there is no indication whatsoever in Gaible et al that the storage bag of Gaible be usable to envelope the entire upper and bottom surfaces of a keyboard without impeding an operator's ability to manipulate a keyboard.

The Examiner concedes that Gaible et al "do not necessarily teach the cover is used for covering a keyboard" (FR at p. 4). The bag of Gaible et al does not teach the cover of the present invention that includes "a predetermined size in length and width to contact and overlie an entire upper surface of a keyboard", as recited in claim 32. Claim 32 also recites "said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator" which necessarily discloses the physical dimensions of a sheet needed to cover the keyboard in which the sheet is used. The Gaible et al plastic is not sufficiently pliable to permit typing depression of keys of a keyboard nor would a person having ordinary skill in the art even attempt to use Gaible et al in the manner disclosed in the instant application. Finally, Gaible et al teaches an opaque portion 230, (col. 4, beginning line 66), as well as a write on portion (col. 4, beginning at line 53).

The discussion hereinabove with regard to claim 32 is believed to be applicable to claims 35-37 and claims 41-42.

B. Claims 32 and 35-37 are believed to be patentable over Yanagisawa '527 in view of Adair '188. Claim 32 provides "a flat entirely transparent planar sheet of pliable plastic film of uniform thickness throughout" and is clearly not obvious in light of Yanagisawa, which employs a rubber band in the embodiments of FIGS. 9 and 10. Moreover, the cover 34 works in conjunction with a "partition member" 32 to which the rubber band is attached to secure the cover 34 or 34'. Accordingly, it is not even clear that the cover of Yanagisawa would stay in place on the keyboard or a portion thereof without the rubber bands.

With respect to Adair, the disclosure recites a body 13 which may conform to the particular shape of the monitor module used. Adair is simply a bag that employs an adhesive tape as a closure and a vacuum line to evacuate the bag.

Applicant believes that Yanagisawa and Adair are not properly combinable. Yanagisawa teaches a flat sheet that requires rubber bands to be used to secure it to a

portion or all of a keyboard whereas Adair teaches a bag that is sealed with tape. Moreover, one skilled in the art to which Yanagisawa's invention is directed would not obviously reconstruct Yanagisawa by any alleged teaching gleaned from Adair. In addition, Adair does not provide an elongated opening as the present invention. Adair's opening is rolled up and taped shut.

Accordingly, claims 32, 35-37 are not obvious in light of the cited art.

C. Claims 33-34 are believed to be patentable in view of Adair, as above, and further in view of Okamura '690 or Young (GB '922A). The Okamura '690 and Young '922A references both employ molded keyboard covers and accordingly are not properly combinable with Yanagisawa. Moreover, the bag of Adair does not teach or suggest the use of adhesive tape to attach the bag to a keyboard or other enclosed apparatus in the bag.

In addition, the use of rubber bands to attach a cover as in Okamura is not the same as adhesive strips to connect to a keyboard.

Finally, it is important to note that claims 33-34 depend on claim 32 which as hereinabove set forth is not taught or suggested by the cited art in any appropriate combination.

D. Claims 21 and 24-26 are believed to be patentable over Yanagisawa '527 and Adair '188 and further in view of the IBM Technical Disclosure Bulletin, June 1994. Claim 21 recites "at least one flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout", thus clearly distinguishing over the cited art in any appropriate combination.

Applicant repeats that the combination of Adair, a bag, and Yanagisawa, a plastic sheet held in place by rubber bands, are not appropriately combined. Further, the IBM reference bears no resemblance whatsoever to the sheet recited in claim 21.

E. Claims 22-23 are believed to be patentable over the cited art for the reasons cited hereinabove in paragraph D with regard to claims 21, 24-26 and paragraph C with regard to claims 33-34. The above reasons are equally applicable to the package of covers as recited in claim 21.

Accordingly, claims 22-23 are not believed to be obvious in light of the cited art in any appropriate combination.

F. Claims 21, 24-26, and 28-30 are believed to be patentable over Gaible et al '182 in view of the IBM reference for the reasons discussed hereinabove in paragraphs A and D. Claim 21 recites an "entirely" transparent sheet of uniform thickness "throughout" which is not taught or suggested by the cited art in any appropriate combination whether individually or in a package.

Accordingly, claims 21, 24-26, and 28-30 are believed to be not obvious.

APPLICABLE LAW

1. ANTICIPATION

A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. Moreover, a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.

See Schering Corp. v. Geneva Pharmaceuticals, Inc. 339 F3d 1373, 67 USPQ 2d 1664 (Fed. Cir. 2003).

2. NON-OBVIOUSNESS

The Federal Circuit has reviewed the standards that are to be applied in analyzing an application for obviousness under 35 U.S.C. 103 in the case of In re Lee, 277 F3d 1338, 61 USPQ 2d 1430 (2002).

The Court stated that it is fundamental that a rejection for obviousness must be based on evidence that is comprehended by the language of the statute. When the issue is obviousness "the search for and analysis of the prior art includes evidence relevant to the finding of whether there is teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." Accordingly, the central question is whether there are reasons to combine the references. Teachings of references can be combined only if there is some suggestion or incentive to do so.

The Court further found that the case law required that there must be some motivation, suggestion, or teaching regarding the desirability of making the specific combination that was made by the applicant. The Court further stated:

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”

Lee case at 1433, quoting In re Dembiczak, 175 F3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).

The Court further found that the need for specificity was pervasive in the prior case law and that:

“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”

quoting In re Kotzab, 217 F3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000).

In addition, the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, Lee case at 1434.

In the Kotzab case, the Federal Circuit Court stated:

“A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”... Most if not all inventions arise from a combination of old elements... Thus, every element of a claimed invention may often be found in the prior art... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention... Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant... Even when obviousness is based on a single prior art reference, there

must be a showing of a suggestion or motivation to modify the teachings of that reference...The motivation suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved...In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references...The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." [At 1316-1317 (all internal citations being omitted)].

Accordingly, applicants believe that each of the claims, herein appealed, should be found to be allowable and this Board should reverse the Examiner as to each of such claims.

IX. APPENDIX OF CLAIMS (37 C.F.R. § 1.192 (c)(9))

CURRENT STATUS OF CLAIMS

- | | |
|-----------------------------|-----------------------------|
| 1. (cancelled). | 28. (previously presented). |
| 2. (cancelled). | 29. (previously presented). |
| 3. (cancelled). | 30. (original). |
| 4. (cancelled). | 31. (previously presented). |
| 5. (cancelled). | 32. (previously presented). |
| 6. (cancelled). | 33. (original). |
| 7. (cancelled). | 34. (original). |
| 8. (cancelled). | 35. (original). |
| 9. (cancelled). | 36. (original). |
| 10. (cancelled). | 37. (original). |
| 11. (cancelled). | 38. (original). |
| 12. (cancelled). | 39. (cancelled). |
| 13. (cancelled). | 40. (cancelled). |
| 14. (cancelled). | 41. (previously presented). |
| 15. (cancelled). | 42. (original). |
| 16. (cancelled). | |
| 17. (cancelled). | |
| 18. (cancelled). | |
| 19. (cancelled). | |
| 20. (cancelled). | |
| 21. (previously presented). | |
| 22. (previously presented). | |
| 23. (previously presented). | |
| 24. (previously presented). | |
| 25. (previously presented). | |
| 26. (previously presented). | |
| 27. (previously presented). | |

21. (previously presented) A package of individual disposable transparent covers of a predetermined size in length and width for protecting the sterility of a keyboard of a computer, each said cover comprising at least one flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout and a predetermined size in length and width to contact and protect an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.

22. (previously presented) The package of Claim 21 wherein said at least one sheet is rectangular, having a long top edge portion, a long bottom edge portion, and two short side edge portions, a strip of adhesive along at least said top edge portion adapted to be attached along a top edge portion of a keyboard.

23. (previously presented) The package of Claim 21 wherein said at least one sheet includes top and bottom edge portions, a pair of spaced strips of adhesive along respective said top and bottom edge portions adapted to be attached along elongated upper and lower portions of an upper surface of a keyboard.

24. (previously presented) The package of Claim 21 wherein said at least one sheet contacts and protects entire upper and bottom surfaces of a keyboard to maintain a keyboard sterile.

25. (previously presented) The package of Claim 21 wherein said at least one sheet is formed with an upper member and a lower member, said upper member being adapted to overlie an upper surface of a keyboard and said lower member being adapted to underlie a bottom surface of a keyboard.

26. (previously presented) The package of Claim 24 wherein said at least one sheet is formed as an envelope with an elongated opening along an elongated top edge portion.

27. (previously presented) The package of Claim 24 wherein said at least one sheet is formed as an envelope with an elongated opening adjacent one corner and extending along one side edge portion and generally to a midpoint along a top edge portion.

28. (previously presented) The package of Claim 21 wherein said at least one sheet includes a pair of identical flat sheets of plastic film, each said sheet having an elongated top edge portion, an elongated bottom edge portion, and two short side edge portions, said sheets being fastened together along said bottom edge portion of each said sheet so as to envelope entire upper and bottom surfaces of a keyboard.

29. (previously presented) The package of Claim 28 wherein said two identical flat sheets of said plastic film are fastened together along each of said side edge portions with one long opening along said top edge portion to permit a keyboard to be inserted therein so as to cover both upper and bottom surfaces of a keyboard.

30. (original) The package of Claim 28 wherein said two identical flat sheets of plastic film are also fastened together along said elongated top edge portion so as to form an elongated envelope having at least one of said short side edge portions open.

31. (previously presented) The package of Claim 30 wherein said top edge portions of said sheets adjacent said at least one open short side edge portions is open to generally a midpoint of said top edge portions.

32. (previously presented) An individual disposable transparent cover having a predetermined size in length and width for protecting the sterility of a keyboard of a computer, comprising a flat and entirely transparent planar sheet of pliable plastic film of uniform thickness throughout and a predetermined size in length and width to contact and overlie an entire upper surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator of a keyboard while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner.

33. (original) The cover of Claim 32 wherein said sheet is rectangular, having a long top edge portion, a long bottom edge portion, and two short side edge portions, a strip of adhesive along at least said top edge portion adapted to be attached along a top edge portion of a keyboard.

34. (original) The cover of Claim 32 wherein said sheet includes top and bottom edge portions, a pair of spaced strips of adhesive along respective said top and bottom edge portions adapted to be attached along elongated upper and lower portions of an upper surface of a keyboard.

35. (original) The cover of Claim 32 wherein said sheet contacts and protects entire upper and bottom surfaces of a keyboard to maintain a keyboard sterile.

36. (original) The cover of Claim 32 wherein said sheet is formed with an upper member and a lower member, said upper member being adapted to overlie an upper surface of a keyboard and said lower member being adapted to underlie a bottom surface of a keyboard.

37. (original) The cover of Claim 35 wherein said sheet is formed as an envelope with an elongated opening along an elongated top edge portion.

38. (original) The cover of Claim 35 wherein said sheet is formed as an envelope with an elongated opening adjacent one corner and extending along one side edge portion and generally to a midpoint along a top edge portion.

39. (cancelled).

40. (cancelled).

41. (previously presented) A disposable transparent cover individually formed and having a predetermined size for protecting the sterility of a keyboard of a computer, said cover comprising two identical flat entirely transparent planar sheets of pliable plastic film of a predetermined size to protect an entire upper and bottom surface of a keyboard, said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator of a keyboard while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner, and each sheet having an elongated top edge portion, an elongated bottom edge portion, and two short side edge portions, said sheets being fastened together along said bottom edge portion of each said sheet so as to envelop entire upper and bottom surfaces of a keyboard.

42. (original) The cover of Claim 41 wherein said two identical flat sheets of plastic film are fastened together along each of said side edge portions with one long opening along said top edge portion to permit a keyboard to be inserted therein so as to cover both upper and bottom surfaces of a keyboard.

X. OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR
DESIRABLE

With respect to claims 24 and 35, applicants are in agreement with the Examiner as to the suggested amendments to these claims, and presumably these can be done by Examiner's Amendment or by formal amendment by applicants after decision on appeal if favorable to applicants.

Respectfully submitted,


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Date: April 26, 2004